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GAY 2871

AMENDMENT TRANSMITTAL LETTER (Large Entity)

Docket No.

45605RE

Serial No.

09/07/97,427

Filing Date

9/21/2000

Examiner

Mr. J.A. Dudek

Group Art Unit

2871

Invention: **LIQUID CRYSTAL DISPLAY FORMED BY A PLURALITY OF NONELECTRICALLY INTERCONNECTED LIQUID CRYSTAL DISPLAY PANELS**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	-	20 =	0 x	\$18.00	\$0.00
INDEP. CLAIMS	-	3 =	0 x	\$80.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$0.00

- ☒ No additional fee is required for amendment.
- ☐ Please charge Deposit Account No. _____ in the amount of _____
A duplicate copy of this sheet is enclosed.
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- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 04-1105
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- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☐ Any patent application processing fees under 37 CFR 1.17.

Signature

Dated: April 16, 2001

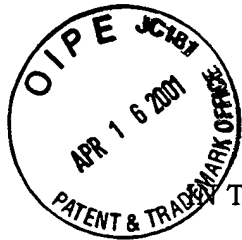
I certify that this document and fee is being deposited on April 16, 2001 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Louise Rappaport

Typed or Printed Name of Person Mailing Correspondence

cc:



Docket No. 904/45605RE

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Y. Izumi

Group: 2871

Filed: September 21, 2000

Examiner: Mr. J. A. Dudek

Serial No.: 09/667,427

FOR: LIQUID CRYSTAL DISPLAY FORMED BY A PLURALITY OF NON-ELECTRICALLY INTERCONNECTED LIQUID CRYSTAL DISPLAY PANELS

The Honorable Commissioner of Patents
And Trademarks

Box: Amendments
Washington, D.C. 20231

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CERTIFICATE OF MAILING

I, hereby certify that this Amendment is being deposited with the United States Postal Service as Express Mail Label #EL730721703US in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on April 16, 2001.

Louise Rappaport
Louise Rappaport

RESPONSE TO OFFICE ACTION

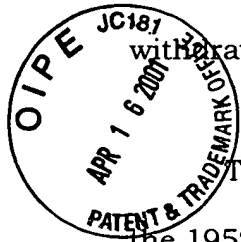
The allowance of claims 1-48 and 50-53 is noted with appreciation.

Claims 49 stands rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent on which the present reissue is based. The rejection is respectfully traversed.

The cases of *Hestor Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed.Cir. 1998); *In re Clemens*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed.Cir. 1997) and *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289, 295 (Fed.Cir. 1984),

cited in the Office Action, support the issuance of claim 49 as amended, and the

with the withdrawal of the present rejection.



The *Bell* case surveyed the cases decided on the issue since the enactment of the 1952 statute, and aptly stated the law of recapture as it has been interpreted by those cases:

The 1952 revision of the patent laws made no substantive change in the definition of error under section 251.n9. While deliberate cancellation of a claim cannot ordinarily be considered error, [*] the CCPA has repeatedly held that the deliberate cancellation of claims may constitute error, if it occurs without deceptive intent.[*] In *In re Petrow*,[*] the CCPA went so far as to state that error is sufficient where the deliberate cancellation of claims does not amount to an admission that the reissue claims were not patentable at the time the original claims were canceled. Similarly, in *In re Wesseler*, [*] the CCPA stated that error is established where there is no evidence that the appellant intentionally omitted or abandoned the claimed subject matter. Thus, the CCPA has construed the term error under section 251 broadly.[*]

n9 [Citing cases] * * *. "Error" is interpreted in the same manner as under section 64 of the old law, i.e., accident, inadvertence, or mistake

221 USPQ at 294 [* footnotes 10 – 14, citing cases, omitted].

Thus the issue is whether the cancellation of claims was intended as an admission that the reissue claims were not patentable at the time the original case was prosecuted, or amounted to intentional abandonment of the claimed subject matter. As the *Bell* court pointed out, the primary consideration was the intent of the patentee, and often there is insufficient evidence of that intent, so sometimes intent is inferred from the change in scope of the claims. See *Bell*, 221 USPQ at 294:

While claim scope is no oracle on intent, the Government fails to apprehend its role. Rarely is evidence of the patentee's intent in canceling a claim presented. Thus, the court may draw inferences from changes in claim scope **when other reliable evidence of the patentee's intent is not available**. Claim scope is **not** the lodestar of

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reissue. Rather, the court's reliance on that indicator in the case law appears to be born of practical necessity as the only available reliable evidence. [Emphasis added.]

See also 221 USPQ at 295:

Thus, the applicability of the recapture rule and the sufficiency of error under section 251 turn in this case, **in the absence of other evidence of the patentee's intent**, on the similarity between the reissue and the canceled claims. Narrower reissue claims are allowable; broader reissue claims or reissue claims of the same scope as the canceled claims are not.[*] The subject matter of the claims is not alone controlling.[*] Similarly, the focus is not, as the Government contends, on the specific limitations or on the elements of the claims but, rather, on the scope of the claims.[*] [Emphasis added, * footnotes omitted.]

In the present case, the claim that was cancelled was former claim 1. Claim 49 as proposed herein is clearly narrower than cancelled claim 1, because it incorporates into that claim the subject matter of claim 14.

In re Clement confirmed the necessity to focus on the patentee's intent, overriding mere inferences which might be made in the absence of evidence of such intent. See, e.g., the court's opinion at 45 USPQ2d 1164:

Although **the recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable,"** *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 U.S.P.Q. (BNA) 568, 574 (Fed. Cir. 1984), "the court may draw inferences from changes in claim scope **when other reliable evidence of the patentee's intent is not available,**" *Ball*, 729 F.2d at 1436, 221 USPQ at 294. * * * [Emphasis added.]

Hester Industries Inc. v. Stein Inc. focused sharply on the patentee's intent, and fully agreed with the predecessor opinions that evidence of the patentee's intent is controlling. See, e.g., 46 USPQ2d at 1648:

This court's prior opinions indicate that, as a general proposition, in determining whether there is a surrender, the prosecution history of the original patent should be examined for **evidence of an admission** by the patent applicant regarding patentability. See *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164 (noting that, with regard to claim amendments, **the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable**); *Mentor*, 998 F.2d at 995, 27 USPQ2d at 1524 (same); *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984) (declining to apply the recapture rule when there was no evidence that the "amendment . . . was in any sense an admission that the scope of [the] claim was not patentable").

In the present case, there is no need to rely on implications drawn from changes in scope, because the patentee's intent is simply and clearly stated on the record. See the response to final rejection, filed April 4, 1997, at page 17:

New claims 48-51 are added herewith and do not raise new issue[s] since they are based on combining claims already in the application. Specifically, **new claim 48 corresponds to claims 1 and 14 combined**; 49 corresponds to claims 1 and 19 combined; 50 corresponds to claims 1 and 33 combined; and 51 corresponds to 1 and 36 combined. * * * [Emphasis added.]

The intent was to replace claim 1 as previously amended with a claim including not only the recitations of claim 1, but also the recitations of claim 14. Thus claim 48 as submitted in that response to final rejection read as follows:

48. (New) A liquid crystal display comprising:

a plurality of interconnected liquid crystal panels connected to each other adjacently on a single surface, each liquid crystal panel including a respective pixel electrode to form a liquid crystal display main body;

a first polarizing element provided on substantially an entire front surface of said liquid crystal display main body, said first polarizing element having a first polarizing axis; and

a second polarizing element provided on substantially an entire rear surface of said liquid crystal display main body, said second polarizing element having a second polarizing axis, said first and second polarizing axes intersecting at right angles wherein lack of electrical interconnection between said plurality of liquid crystal panels facilitates minimizing spacing there between and configuration of said first polarizing element and said second polarizing element renders any spacing less noticeable;

said display further including a photo blocking film disposed perpendicular to said display and configured to substantially block diagonal incident light; and

said liquid crystal panels including panel substrates **laminated by means of a seal material made of an ultraviolet-ray-setting resin.**

Emphasis added. That response to the final rejection was denied entry, on the grounds that it raised new issues requiring further consideration or search.

Accordingly, applicants filed a CPA, in order to get the new claims considered. A preliminary amendment was submitted which was clearly intended to submit 48 in the same form, and for the same purpose it had been submitted in the response to the final rejection in the parent case. See the Preliminary Amendment, submitted August 6, 1997 in the CPA application, at page 14:

New claims 48-51 are added herewith. Specifically, **new claim 48 corresponds to claims 1 and 14 combined**; 49 corresponds to claims 1 and 19 combined; 50 corresponds to claims 1 and 33 combined; and 51 corresponds to 1 and 36 combined. [Emphasis added.]

Again, the evidence of applicants' intent is plain on the record of the file history: replace claim 1 with claim 48, which was supposed to be a combination of claim 1 and claim 14. Unfortunately, however, in copying over the claims from the unentered response to the final rejection in the parent application, a typographical

error was made, in which a few extra words were included in claim 48, so that it did not correspond to a combination of claim 1 and claim 14 ("laminated by means of a seal material made of an ultraviolet-ray-setting resin"), as intended, but effectively amounted to a combination of claim 1 and claim 19 ("laminated by means of a seal material made of **a combination of thermosetting and** ultraviolet-ray-setting resin.") As a result of this typographical error, claim 48 as submitted was identical to claim 49 as submitted. In the patent, claim 48 was renumbered as patent claim 49, and claim 49 was renumbered as claim 50, and, because of this typographical error, both claims are identical.

This is precisely the kind of inadvertent error, made without deceptive intent, that the reissue statute was designed to correct. Unfortunately, the typing error was not discovered until the patent was reviewed. Until then, the applicants believed they were patenting the combination of claim 1 with the recitations of claim 14.

Indeed, if inferences are to be drawn, it seems probable that the Examiner believed that he was issuing a claim which was a combination of claim 1 with the recitations of claim 14. It is most unlikely that the Examiner decided to allow two identical claims corresponding to patent claim 50. Rather, it is supposed, the Examiner understood from applicants' remarks that newly submitted claim 48 was directed to the combination of claim 1 and claim 14, and claim 49 was directed to a combination of claim 1 with claim 19. Although claims 14 and 19 had been rejected, no prior art reference discussed or suggested any aspect of either claim, as the applicants pointed out, both in the unentered response to the prior final rejection, and in the preliminary amendment. Note that the arguments which supported the

patentability of newly submitted claims 48 and 49 were directed to the use of ultraviolet-curing resins to bind elements together, fully applies to establish the patentability of both claims, each of which recites the use of such resins:

The Examiner asserted that claims 14 and 19 are obvious, but provided no cited reference as the basis for such rejection. New claims 48 and 49 provide for the features of a large-screen liquid crystal display which is made by sticking plural panels together to make the joints of the panels inconspicuous. In the newly added claims as a result, compared with using thermosetting resin, display areas are effectively prevented from erosion due to heat. Therefore, borders of the panels which do not contribute to display become narrow, and ends of the display areas are made to exist as close as possible to the borders. Consequently, the joints of the panels become inconspicuous. The arrangements of these claims are techniques that make the joints of the panels inconspicuous using an ultraviolet-ray-setting resin as a seal material for a large-screen liquid crystal display which is made by sticking panels together, and therefore the arrangements cannot be anticipated from conventional liquid-crystal display techniques which do not stick plural panels together. Moreover, they are not taught nor suggested by the conventional techniques which stick plural panels together or by the primary reference of Kibe which has been discussed in previous responses. Emphasis in original.

In *Hestor*, the patentee was trying to broaden the reissue claims by excluding limitations which had been argued as critical throughout prosecution. The court found admissions that the claims sought in reissue were unpatentable over the prior art. The court found a surrender of the subject matter of the reissue claims during the original prosecution.

In the present case, the reissue application is fully consistent with the arguments made during the original prosecution. Applicants argued that claims 14 and 19 were patentable. There was no prior art suggesting the use of ultraviolet-ray-curing resin to bind the elements together, and nothing suggested the benefits obtained thereby. The Office agreed. Unfortunately, an innocent typographical error

deprived the patentee from the claim everyone thought they were agreeing on. That is precisely the type of "accident, inadvertence or mistake" which the *Ball* court considered to be correctable by reissue.

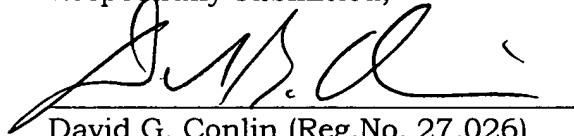
Claim 49 as amended is not broader than claim 1 as it was cancelled in being combined with claim 14. The intent, as clearly stated on the record, was not to say that claim 14 is unpatentable over the art, or to abandon that claim. There was no pertinent prior art. Claim 49 is not broader than old claim 1 in any sense. It is narrower in the way it was intended to be narrower from the beginning. It is clearly patentable over the prior art.

Accordingly, it is respectfully requested that the rejection of claim 49 be reconsidered and withdrawn. There is no broadening aspect in the reissue which was not present in the application as originally prosecuted. Claim 48, as actually presented in response to the final rejection, and as clearly intended to be presented in the preliminary amendment in the CPA, is the same as claim 49 as presently amended. Claim 49 does not relate to any subject matter surrendered by the applicant during the original prosecution. Prior claim 1 did not contain the recitations of claim 14, and the evidence of intent is entirely contrary to any notion of surrender. Claim 14 was never cancelled nor surrendered in any way during the prosecution of the parent or CPA applications.

Reconsideration and allowance of all the claims are earnestly solicited. If the undersigned can be of any assistance in resolving any questions or expediting the

prosecution of this application, the Examiner is invited and requested to contact the undersigned collect at the number or email address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Conlin', is written over a horizontal line.

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